

REMARKS

In the Final Office Action, the Examiner rejected claims 1-26 and 28-31. Further, the Examiner objected to claim 27 for depending from a rejected base claim, but indicated that this claim contains allowable subject matter. Applicants thank the Examiner for the recognition of allowable subject matter in the present claims. By the present Response, Applicants amend claims 1, 22, and 28, and add new claims 32-35 to further clarify the claimed subject matter. Upon entry of the amendments, claims 1-35 will remain pending in the present patent application. Applicants respectfully request reconsideration of the above-referenced application in view of the foregoing amendments and following remarks.

Objections to the Drawings and the Specification

In the Final Office Action, the Examiner objected to the drawings, stating that the drawings must show every feature of the invention specified in the claims. More particularly, the Examiner stated, “the ‘a hard drive securing mechanism’ claimed in claim 1, and ‘a securing lever mechanism’ in claim 14 must be shown or the feature(s) canceled from the claim(s).” Final Office Action mailed March 9, 2005, pg. 2. The Examiner also objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner suggests that a “hard drive securing mechanism,” as recited in claim 1, and a “securing lever mechanism” are not discussed in the specification, and that the reference character “60” has been used to designate both “lever” and “carrier.”

While Applicants do not necessarily agree with these objections, Applicants have amended the specification in the interest of advancing prosecution of the present application. Particularly, Applicants amended the specification to provide unequivocal antecedent basis for the use of the terms “hard drive securing mechanism” and “securing lever mechanism,” and that reference numerals 40 and 60 represent one embodiment of these terms, respectively. These amendments are clearly supported by the *original*

specification, including the original claims. Further, Applicants thank the Examiner for pointing out a clerical error pertaining to the inadvertent use of reference numeral 60 with the term “carrier” in the specification. Applicants also amended the specification to correct this discrepancy. Applicants respectfully submit that the present amendments to the specification obviate the Examiner’s objections to both the specification and the drawings. Consequently, Applicants respectfully request withdrawal of the present objections.

Claim Rejections under 35 U.S.C. § 102

In the Final Office Action, the Examiner rejected claims 1-9, 11, 14-19, 22-25, and 28-31 under U.S.C. § 102(b) as anticipated by Cooke et al. (U.S. Patent No. 5,112,119). Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984).

Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the . . . claim*” to support a *prima facie* case of anticipation.

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

The Cooke et al. reference does not teach or disclose a “lever” as the term would be understood by one skilled in the art.

As a preliminary matter, Applicants again respectfully submit that the Cooke et al. reference fails to teach any structure that may be reasonably equated with a “lever” as recited in independent claims 1, 14, 22, and 28. To the contrary, the Examiner has twice asserted that retainer 420 of the Cooke et al. reference may be equated with the recited lever. *See* Final Office Action mailed March 9, 2005, pg. 3-7, 10; Office Action mailed October 20, 2004, pg. 4-8; *see also* Response to Office Action filed January 19, 2005, pg. 10-12 (providing comparative analysis of the retainer 420 to the present claims). The Examiner’s rejection of the current claims relies on this comparison.

Applicants thank the Examiner for providing, in the most recent Office Action, a rationale for classifying retainer 420 as a lever in response to Applicants previous arguments, which are incorporated herein by reference. However, Applicants respectfully submit that the Examiner’s rationale for comparing the retainer 420 to a lever is based on a characterization of retainer 420 that is not supported by the Cooke et al. reference. In the recent Office Action, the Examiner cited column 11, lines 14-16, and column 15, lines 21-25, of the Cooke et al. reference as disclosing that retainer 420 *transmits force to disk drives* upon rotation about a pivot. However, a careful analysis of the cited passages reveals no such teaching.

The Cooke et al. reference is directed to an apparatus for housing devices, such as disk drives, within a computer. *See* col. 1, lines 7-10. To this end, the Cooke et al. reference teaches an apparatus having an enclosure or case 15 and a disk drive support structure 20. *See* col. 3, lines 18-20; FIG. 1A. Further, the cited reference teaches a drive retainer 420 having retainer contact tabs 535 and 540 that act as respective stops at one end of the support structure 20 to prevent movement of drives in a single direction. *See* col. 14, lines 6-12; *see also* FIGS. 19A and 19B. In other words, the drive retainer 420 simply *blocks removal* of a disk drive already installed in the structure 20, rather than

providing any leverage over the course of attaching the drive retainer 420 to the structure 20. *See id.*

The first passage relied upon by the Examiner merely states that “drive retainer 420 . . . aids in *holding* any drives in place which are installed in bays C, D and E” (emphasis added). Applicants respectfully point out that holding an object *is not equivalent to* transmitting force to an object. For illustrative purposes, it may be helpful to consider any number of hypothetical examples, such as the lid on a cardboard box. As may be appreciated, boxes are frequently used to hold or retain things. The lid of such a cardboard box does pivot when opening and closing the box. The lid of the box aids in holding the contents of the box by preventing items in the box from falling out if the box is overturned. However, the mere fact that the lid is capable of pivoting and assists in holding the contents of the box does not make the lid a lever. Similarly, the gate of a cage or fence may aid in holding an animal within the cage or fenced area, but such a gate could not be reasonably considered a lever for the mere fact that it aids in holding an animal. Likewise, the first passage relied upon by the Examiner clearly discloses that retainer 420 of the Cooke et al. reference merely aids in holding the drives, which is in accord with the decision of Cooke et al. to refer to element 420 as a “retainer” instead of a “lever.” The passage does not in any way suggest that the retainer 420 transmits any force to a second object and, consequently, cannot support the Examiner’s contention in this regard.

Similarly, the second passage relied upon by the Examiner with respect to retainer 420 also fails to support the Examiner’s assertion. *See* col. 15, lines 21-25. This passage teaches that a bezel 575 transmits force to the retainer 420, pushing the retainer 420 toward the housing. Applicants respectfully submit that this passage is irrelevant with respect to the present issue. The mere fact that retainer 420 is biased toward the housing does not support a conclusion that the retainer is applying a force to the disk drives in the housing.

Applicants respectfully submit that the current rejection of independent claims 1, 14, 22, and 28 are improper for at least the reasons provided above and respectfully request reconsideration of the present claims in view of these deficiencies. However, Applicants note that the current rejection is also deficient with respect to the current claims for further reasons as presented below.

Additional Omitted Features of Independent Claim 1

The Cooke et al. reference also fails to disclose additional elements of independent claim 1. For instance, independent claim 1, as amended, recites a “rotatable lever having a tapered guide *configured to receive ... a protruding member of a hard drive*” (emphasis added). Further, claim 1, as amended, also recites “the tapered guide is further *configured to rotate about the protruding member*” (emphasis added). As discussed below, the Cooke et al. reference fails to disclose such elements. Consequently, the Cooke et al. reference cannot anticipate independent claim 1.

Applicants note that the Examiner, in rejecting subject matter present in dependent claim 3, asserted that the contact tabs 540 of retainer 420 are tapered guides configured to receive an end 190A of rail 190, which the examiner equated with a protruding member of a hard drive. *See* Final Office Action mailed March 9, 2005, pg. 4. However, Applicants respectfully note that even if contact tabs 540 could be considered “tapered guides,” these tabs 540 are not configured to receive any portion of rail 190. In fact, reference to FIG. 15, the same figure relied upon by the Examiner, clearly illustrates that rail 190 is spaced apart from contact tab 540. Because contact tabs 540 are not configured to *receive* any structure, let alone receive “a protruding member of a hard drive” as recited by the present claim, these tabs 540 cannot be logically equated with the tapered guide of independent claim 1.

Still further, the reference clearly fails to teach that the contact tabs 540 are configured to rotate about rail 190. As such, contact tabs 540 cannot be reasonably

compared to a tapered guide “configured to rotate about the protruding member.” Because the Cooke et al. reference fails to disclose each and every element of independent claim 1, the cited reference cannot support a *prima facie* case of anticipation of the instant claim. Accordingly, Applicants believe independent claim 1, as well as its dependent claims, is patentable over the Cooke et al. reference.

Additional Omitted Features of Independent Claim 14

Similarly, in addition to failing to disclose a securing lever mechanism, the Cooke et al. reference fails to disclose other recitations of independent claim 14. For example, independent claim 14 recites, “a hard drive carrier held by a first plurality of guides and *configured to support a plurality of hard drives*” (emphasis added). In the Final Office Action, the Examiner equated adapter tray 200 of the Cooke et al. reference with the presently recited hard drive carrier. However, the cited reference clearly indicates that each adapter tray 200 may be used to adapt a *single* smaller drive, such as 3.5 inch hard drive, to fit in a 5.25 inch slot. *See* col. 7, lines 38-49; FIG. 11. Because the adapter tray 200 is configured to support a single hard drive, it certainly cannot be equated with “a hard drive carrier ... configured to support a *plurality* of hard drives” as recited by independent claim 14. As a result, the Cooke et al. reference fails to disclose every element of, and cannot anticipate, independent claim 14. Accordingly, Applicants believe independent claim 14, as well as its dependent claims, is patentable over the Cooke et al. reference.

Additional Omitted Features of Independent Claim 22

Further, in addition to failing to disclose a securing lever, the Cooke et al. reference also fails to teach or suggest each element of independent claim 22. By way of example, independent claim 22, as amended, recites “disposing a first hard drive between a first restraint and a securing lever *by rotating the first hard drive into position* between the first restraint and the securing lever” (emphasis added). The hard drives of the Cooke et al. reference are inserted into the Cooke et al. apparatus by sliding them into position.

Col. 6, lines 32-38; FIG. 7. As such, the cited reference cannot be reasonably considered to disclose “rotating the first hard drive into position” as recited by independent claim 22. Thus, the Cooke et al. reference fails to anticipate independent claim 22. Applicants, therefore, believe independent claim 22, as well as its dependent claims, is patentable over the Cooke et al. reference.

Additional Omitted Features of Independent Claim 28

Additionally, the Cooke et al. reference fails to disclose other limitations of independent claim 28. For instance, independent claim 28 recites, among other things, plurality of guides “*configured to receive a protruding member* when the securing lever is in a first position and to restrict the protruding member when the securing lever is in a second position different from the first position.” As discussed above with respect to claim 1, the contact tabs 540 of the Cooke et al. apparatus are not configured to receive *anything*, let alone a protruding member of a hard drive. As such, these contact tabs cannot be reasonably compared with the presently recited guides. For this reason alone, the Cooke et al. reference cannot anticipate independent claim 28.

Further, even assuming for the sake of argument that retainer 420 could be considered a lever, and that contact tabs 540 could be equated with guides, it is clear that the contact tabs 540 do not receive a protruding member, such as rail 190, in a different position than the position in which the contact tabs 540 restrict movement of the Cooke et al. hard drives. Applicants note that the retainer 420 restricts the hard drives when rotated completely into retaining position. However, this retaining position also is the position in which the contact tabs 540 are in closest proximity to the rail 190. Even if contact tabs could “receive” rail 190, the retainer 420 would have to be in the same, *retaining position* in order to receive the rail. As such, the teachings of the Cooke et al. reference are antithetical to the present recitation that the guides are “configured to receive a protruding member *when the securing lever is in a first position* and to restrict the protruding member *when the securing lever is in a second position* different from the

first position" (emphasis added). Because the Cooke et al. reference fails to disclose each element of the instant claim, the cited reference cannot anticipate independent claim 28. Consequently, Applicants believe independent claim 28, as well as its dependent claims, is patentable over the Cooke et al. reference.

For these reasons, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 102 and allow claims 1-9, 11, 14-19, 22-25, and 28-31.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 10, 12, 13, 20, 21, and 26 under 35 U.S.C. § 103(a) as obvious over Cooke et al. in view of Kikinis (U.S. Patent No. 5,539,616). Applicants respectfully traverse this rejection.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Deficiencies of the Cited References

With respect to the rejection of claims 10, 12, 13, 20, 21, and 26, as discussed above, the Cooke et al. reference fails to disclose every element of independent claims 1, 14, and 22, from which claims 10, 12, 13, 20, 21, and 26 respectively depend. Further, the Kikinis reference fails to obviate the deficiencies of the Cooke et al. reference. As a result, claims 10, 12, 13, 20, 21, and 26 are allowable on the basis of their dependency from an allowable independent claim, as well as by virtue of the subject matter separately recited in each dependent claim. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 10, 12, 13, 20, 21, and 26.

New Claims

In addition, Applicants stress that the new claims recite additional features missing from the cited references. Consequently, these new claims are believed to be in condition for allowance.

Serial No. 09/717,555

Request for Continued Examination; Amendment and
Response to Final Office Action mailed March 9, 2005

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: June 9, 2005



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